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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

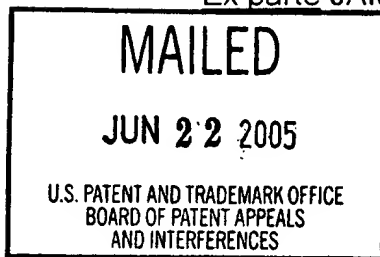
Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

SEP 13 2005
DIRECTOR OFFICE
TECHNOLOGY CENTER 2000

Ex parte JAMES B. ARMSTRONG and CRAIG T. JORGENSEN



Appeal No. 2005-0972
Application No. 09/538,816

ON BRIEF

Before KRASS, DIXON, and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-15.

The invention pertains to adapting service levels in an information distribution system in response to an amount of bandwidth available within the information distribution system. In particular, a video-on-demand (VOD) content stream is provided

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to a consumer and, in response to a pause command from the consumer, halting the VOD content stream and providing a secondary content to the consumer.

Representative independent claim 1 is reproduced as follows:

1. In an interactive information distribution system including information provider equipment and information consumer equipment, a method for use in an information server comprising the steps of:

providing a primary video-on-demand (VOD) content stream to an information consumer;

and in response to a stop or pause command received from said information consumer, performing the steps of:

halting the providing of said primary VOD content stream to said information consumer; and

providing a secondary content to said information consumer.

The examiner relies on the following references:

Dedrick	5,724,521	Mar. 03, 1998
Inoue et al. (Inoue)	5,729,280	Mar. 17, 1998
Mankovitz	WO 98/48566	Oct. 29, 1998

Claims 1-15 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Mankovitz and Inoue with regard to claims 1, 2, 4, and 6-8, adding Dedrick with regard to claims 3, 5, 9, and 10-15.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the

evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived.

With regard to independent claim 1, the examiner contends that Mankovitz discloses a system whereby a primary content stream is provided to an information consumer (page 5, line 25) and, in response to a pause command received from the consumer (page 7, line 30, through page 8, line 5, and page 8, line 34), the content stream is halted and a second content is provided to the consumer (Figure 2).

The examiner acknowledges that Mankovitz does not disclose that the primary content stream is the claimed VOD. But, the examiner turns to Inoue for allowing a user to request reception and display of a VOD stream (column 5, lines 18-20, and 28-32). The examiner also contends that Inoue discloses, at column 6, lines 29-32, that during a pause, a program may continue to be displayed, or another program (secondary content) may be received and displayed.

Thus, concludes the examiner, since Inoue evidences that the artisan would have appreciated the ability to implement VOD streaming in a television system with a pause function, displaying a secondary program stream, it would have been obvious to modify the method of Mankovitz with the VOD demand of Inoue "in order to offer users the ability to request and view program content at any time to increase revenue" (Paper No. 8, page 3).

For their part, appellants argue that neither of the references discloses a VOD content stream, as claimed. They argue that the examiner admits that Mankovitz is not directed to a VOD system and while the examiner relies on Inoue for a VOD content stream, Inoue, in fact, discloses only a near video-on-demand (NVOD) system. As appellants explain it, at page 18 of the principal brief,

...near video-on-demand is not the same as video-on-demand services, since video-on-demand services provide a single content stream to a subscriber at any time of the day, as opposed to near video-on-demand services that provide multiple content streams in particular time slots on various channels.

Thus, appellants conclude, the references provide no teaching, suggestion, or motivation

that the halting of the providing of the primary VOD content stream and providing a secondary content to the information consumer in response to a stop or pause command is applicable to a system that provides video-on-demand services, as opposed to television broadcasting programs or near video-on-demand services (principal brief-page 19).

Appellants explain that because of the many advantages of VOD over NVOD (less bandwidth and fewer additional resources required), it would not have been obvious to apply Inoue's teaching of a NVOD content stream to a VOD content stream.

We have reviewed the evidence in this case, including the arguments of appellants and the examiner, and we conclude that the subject matter of instant claim 1 would have been obvious, within the meaning of 35 U.S.C. § 103, over Mankovitz and Inoue.

Appellants do not dispute that the applied combination of references suggests providing a primary NVOD content stream to an information consumer; and in response to a stop or pause command received from said information consumer, performing the steps of: halting the providing of said primary NVOD content stream to said information consumer; and providing a secondary content to said information consumer.

Rather, appellants stress that the instant claim calls for a VOD, rather than a NVOD, content stream to be provided and that it is a VOD, rather than a NVOD, content stream which is halted.

While we acknowledge the difference between VOD and NVOD (VOD provides a single content stream to a subscriber at any time of the day; NVOD provides multiple content streams in particular time slots on various channels), both systems deal with

providing a content stream of information to a consumer. We find that whether it is a VOD or a NVOD system providing the content stream of information (one can choose to look at a single one of the multiple content streams provided in NVOD), the combination of applied references still suggests a content stream provided to an information consumer and, in response to a stop command from the consumer, halting the content stream and providing a different, or secondary, content to the consumer. Accordingly, we find that the artisan would have found it equally obvious to provide either a primary VOD or NVOD content stream to a consumer and, responsive to a stop command from the consumer, to halt providing the VOD or NVOD content stream to the consumer and provide a secondary content to the consumer. Especially note column 6, lines 24-32, of Inoue, where it is taught that during a pause of a program, "another" program may be received.

With regard to appellants' argument that nothing in the references teaches or suggests that the primary video stream "from the source" is halted (reply brief-page 4), we find no claim language commensurate with this argument, i.e., nothing in the claims requires halting the providing of the primary content stream "from the source."

Accordingly, we will sustain the rejection of claim 1 under 35 U.S.C. § 103.

Turning to claim 2, appellants' argument mirrors the argument set forth anent claim 1. Additionally, appellants point out that claim 2 requires restarting the providing

of the primary VOD content stream in response to a play or resume command and that the combined references are silent with respect to this limitation.

We disagree. Mankovitz is clear that the primary content stream is restarted to the consumer in response to a resume command, at page 8, lines 6-7, i.e., the display of the television program is resumed. It is true that Mankovitz's primary content stream is a television program and not a VOD content stream, as claimed, but this was the examiner's reason for combining Mankovitz with Inoue which does show a NVOD content stream. For the reasons supra, we find that it would have been obvious to apply these teachings to a VOD content stream.

Accordingly, we will sustain the rejection of claim 2 under 35 U.S.C. § 103.

With regard to claim 4, appellants again repeat the arguments anent claim 1, but now add that the applied references do not teach or suggest the limitation of the secondary content being determined "with respect to a segment of said primary VOD content stream being presented to said information consumer contemporaneous to said stop or pause command."

However, appellants admit that, with regard to the applied references, "the secondary content is determined with respect to a segment of broadcasted television program [sic] or a NVOD program" (principal brief-page 25). Therefore, it appears, once again, that appellants' argument is really based on the lack of a showing of a

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VOD content stream by the references and how the use of a VOD content stream would not have been obvious over the teaching of a NVOD content stream as in Inoue. For the reasons supra, we disagree and we will sustain the rejection of claim 4 under 35 U.S.C. § 103.

With regard to claim 6, appellants argue that the applied references are silent as to the limitation of determining, for the halted VOD content stream, “the last scene of said primary VOD content stream...”

Clearly, Mankovitz discloses, at page 7, lines 35-37, determining the last scene of the primary content stream being provided to the consumer when the stream is halted (i.e., a first stored frame is output for an extended display). Thus, it is apparent that appellants are really arguing, once again, the claimed VOD content stream feature as distinguishing over the NVOD content stream of Inoue, combined with the Mankovitz teachings. For the reasons supra, we are not convinced of nonobviousness of the claimed subject matter.

Thus, we will sustain the rejection of claim 6 under 35 U.S.C. § 103.

With regard to claim 7, appellants present exactly the same arguments as they did relative to claim 1, viz., claimed VOD vs. Inoue's NVOD. For the reasons supra, we will sustain the rejection of claim 7 under 35 U.S.C. § 103.

Claim 8 recites, inter alia, that the secondary information is provided as an applet comprising a video layer, a control layer and a graphics layer.

It is the examiner's position that Mankovitz's secondary content may be a web page displayed on an Internet web browser (referring to page 6, lines 10-36) and that it is "inherent" in such a web browser environment that there be an "applet" or controlling program (browser) which comprises a video layer, a control layer, and a graphics layer.

We find ourselves in agreement with appellants, as to claim 8. That is, we find no inherency that the software applications of Mankovitz are applets, originating from the provider equipment. There is no reason, other than hindsight, for the examiner to conclude that the secondary content of Mankovitz is inherently derived from applets, and the instant claim specifically requires that this secondary content must be derived from applets. Since an applet is a program written in the Java programming language that can be included in an HTML page, similar to including an image, and the examiner has not shown that the secondary content in Mankovitz must, of necessity, be derived from such a program, the examiner has not met his burden to show that there can be no other way for Mankovitz's secondary content to be derived.

Accordingly, while the secondary content of Mankovitz may very well be derived from applets, the examiner has not set forth a prima facie case of obviousness, comprising a convincing line of reasoning with regard to this claimed limitation.

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Accordingly, we will not sustain the rejection of claim 8 under 35 U.S.C. § 103.

With regard to claims 3, 5, and 9, appellants' argument is essentially identical to that anent claim 1, viz., that the applied references do not teach or suggest the claimed VOD content stream. For the reasons supra, we will sustain the rejection of claims 3, 5, and 9 under 35 U.S.C. § 103.

Finally, we turn to claims 10-15. The only argument we find from appellants is, again, directed to an alleged patentable distinction of the claimed VOD content stream over the prior art NVOD content stream. Once again, for the reasons supra, we will sustain the rejection of claims 10-15 under 35 U.S.C. § 103.

We have sustained the rejections of claims 1-7, and 9-15 under 35 U.S.C. § 103 but we have not sustained the rejection of claim 8 under 35 U.S.C. § 103.

The examiner's decision is affirmed-in-part.

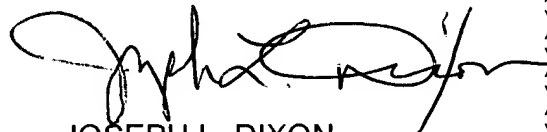
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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a) (1) (iv).

AFFIRMED-IN-PART



ERROL A. KRASS)
Administrative Patent Judge)



JOSEPH L. DIXON)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES



HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

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